



04/21/03

Attorney's Docket No. E00296.70106.US/JHM/

Reybold A

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Yao WANG et al.

Serial No.: 09/533,409

Filing Date: March 22, 2000

For: METHOD AND APPARATUS FOR PROVIDING ADDITIONAL
RESOURCES FOR A HOST COMPUTER

Examiner: Adnam M. Mirza

Art Unit: 2141

Confirmation No.: 8616

Box Non-Fee Amendment
Commissioner For Patents
Washington, D.C. 20231

Sir:

RECEIVED

APR 18 2003

Technology Center 2100

RESPONSE

In response to the Office Action mailed January 14, 2003, reconsideration is respectfully requested in view of the following remarks.

Claims 1 through 61 are pending in this application. Claims 1-61 stand rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. application publication No. US 2002/0016827 A1, published February 7, 2002 to McCabe et al. (hereinafter "McCabe") in view of U.S. Patent No. 6,145,019 to Firooz et al. (hereinafter "Firooz"). This rejection is respectfully traversed.

1. The Cited Sections Of McCabe Are Not Prior Art To This Application

McCabe is the publication of Application Serial No. 09/873,977 (hereinafter "the '977 application"), and did not publish until after the March 22, 2000 filing date of the present application. Thus, although not explained in the Office Action, McCabe can only potentially be prior art under §102(e)(1).

The '977 application was filed on September 2, 2001, again after the filing date of the present application. Thus, portions of McCabe can only be prior art to the present application to the extent they are entitled to an earlier filing date (see MPEP section 706.02 (f)(1)(I), page 700-27, Rev. 1, Feb. 2003).

The '977 application is asserted to be a continuation-in-part of application Serial No. 09/438,184 (hereinafter "the '184 application"), filed November 11, 1999, and a non-provisional application based on several provisional applications, numbers 60/209,469, filed June 5, 2000, 60/223,934, filed August 9, 2000, and 60/262,143, filed January 16, 2001. Based on the March 22, 2000 filing date of the present application, any disclosure in the '977 application that was not in the '184 application is NOT prior art to this application under 35 U.S.C. §102(e)(1).

Significant portions of McCabe which are used in the rejection of claims 1-61 of the present application are not present in the '184 application, and as such are NOT prior art to the present application. Specifically, based upon comparison of the disclosure of a certified copy of the '184 application (a copy of which is enclosed for the Examiner's convenience) and the disclosure of McCabe, the following paragraphs of McCabe are not prior art to this application:

- Page 2, paragraphs 15 through 17;
- Page 3, paragraphs 32 through 36;
- Page 10, paragraph 103;
- Pages 13 though 18, paragraphs 130 through 190; and
- Page 22, paragraphs 243 through 234.

As the rejections of claims 2 through 18 and 48 are based on portions of McCabe that are not entitled to the filing date (November 11, 1999) of the '184 application, and which are NOT prior art to the present application, the rejections of these claims under 35 U.S.C. §103(a) is improper and must be withdrawn.

2. The Office Action Fails to Establish a Prima Facie Case of Obviousness

In paragraph 2, the Office Action asserts that McCabe discloses an act of "detecting a decrease in performance of a first host computer," citing page 20, paragraph 213 of McCabe. The Office concedes that McCabe fails to disclose an act of automatically configuring a second host computer to provide additional computational resources for the first host computer in response to the act of detecting. Nonetheless, the Office Action asserts that Firooz discloses this aspect of the present invention.

Applicants agree that McCabe fails to disclose an act of automatically configuring, but respectfully dispute each of the other assertions.

A. McCabe Does Not Disclose or Suggest Detecting a Performance Decrease of a First Host Computer

Paragraph 213 on page 20 of McCabe contains no disclosure whatsoever that can be construed as detecting a decrease in performance of a first host computer as asserted. All paragraph 213 discloses is that the size and storage capacity for mirroring units 204 and remote mirroring units 208 should have some relationship to the amount of data in the server 200 that is being mirrored. Specifically, McCabe discloses that local buffer 210 should have a storage capacity of at least 6/5 the size of the volume to be mirrored in the server 200, and the remote mirroring unit 208 should have at least one disk system equal in size to the size of the volume to be mirrored. As the cited portion of McCabe does not disclose an act of detecting a decrease in performance of a first host computer, the rejection of claims 1-61 that is premised thereon is improper and fails to establish a *prima facie* case of obviousness.

Indeed, the only discussion of performance to be found on page 20 of McCabe is that directed to test suites for testing the performance of local and remote mirroring units. As described at page 20, paragraph 214 through page 21, paragraph 233, various tests may be used to compare the “performance of a native disk drive (for which the model, size and characteristics are noted) with the performance of a flexible mirroring unit 204.” (See page 20, paragraph 217.) As described therein, these tests relate not to the performance of a host computer as required by Applicants’ claims, but to the performance of a flexible mirroring unit. As McCabe fails to disclose or suggest anything relating to detecting a decrease in performance of a host computer, the Office Action fails to establish a *prima facie* case of obviousness under 35 U.S.C. §103(a), and the rejection of claims 1-61 based thereon should be withdrawn.

B. Firooz Does Not Disclose or Suggest Automatically Configuring a Second Host Computer

With respect to Firooz, this reference similarly fails to disclose or suggest that which is asserted, namely automatically configuring a second host computer in response to a decrease in performance of a first host computer.

Although the Office Action points to column 6, lines 28 through 35 of Firooz, a reading of this reference refutes this assertion. Firooz is generally directed to computer peripheral devices, and more specifically to the automatic configuration of primary and secondary peripheral devices for personal computers. (Col. 1, lines 8-10.) As defined in Firooz, peripheral devices include magnetic disk drives, compact disk drives, tape drives, and some devices other than memory devices that are connected to a host adapter. (Col. 1, lines 13-23.) Firooz makes it clear that the types of devices to which it is directed are those which are peripheral devices, not host computers. Firooz is narrowly directed to avoiding the use of conventional jumpers that were traditionally required to identify whether a particular peripheral device was a primary peripheral device or a secondary peripheral device. (See col. 1, lines 25 though 34). Nowhere does Firooz disclose, teach, or suggest that the peripheral devices may be a host computer as required in the claims. Accordingly, the Office Action also fails demonstrate how the prior art shows this second limitation, such that it fails to establish a *prima facie* case of obviousness for this additional reason.

C. There Is No Motivation For The Asserted Combination

Finally, the Office Action fails to provide any teaching or suggestion to support the assertion that it would have been obvious to one having ordinary skill in the art to “have incorporated [the] automatically configuring a second host computer to provide additional computational resources for the first computer in response to the act of detecting as taught by Firooz in the method of McCabe to reduce latency and cost while being more versatile in terms of functionality.”

Firooz is directed to detecting whether a device is a primary peripheral device or a secondary peripheral device, and whether there are any legacy peripheral devices present. This detection is performed during the initial power-up of a personal computer (see col. 1, line 50- col. 2, line 9), and not in response to an act of detecting a decrease in performance of a first host computer. Indeed, the personal computer has just been powered on. Thus, even if McCabe did disclose or suggest detecting a decrease in performance of a first host computer, which it does not, there is no motivation to combine the teachings of McCabe with those of Firooz, because the

automatic configuration disclosed in Firooz is responsive to the power on of a computer, and not a decrease in performance.

Accordingly, because McCabe clearly does not disclose or suggest detecting a decrease in performance of a first host computer, Firooz does not disclose or suggest automatically configuring a second host computer in response to such a detection, and there is no motivation to combine these references, the Office Action fails to assert a *prima facie* case of obviousness with respect to claims 1-61. Therefore, the rejection of claims 1-61 under 35 U.S.C. §103(a) over the combination of McCabe and Firooz should be withdrawn.

CONCLUSION

In view of the foregoing amendments and remarks, this application should now be in condition for allowance. A notice to this effect is respectfully requested. If the Examiner believes, after this amendment, that the application is not in condition for allowance, the Examiner is requested to call the Applicant's attorney at the number listed below.

If this response is not considered timely filed and if a request for an extension of time is otherwise absent, Applicant hereby requests any necessary extension of time. If there is a fee occasioned by this response, including an extension fee, that is not covered by an enclosed check, please charge any deficiency to deposit account No. 23/2825.

CERTIFICATE OF MAILING UNDER 37 C.F.R. §1.8(a)

I hereby certify that this document is being placed in the United States mail with first-class postage attached, addressed to the Commissioner for Patents, Washington, D.C. 20231 on April 14, 2003.

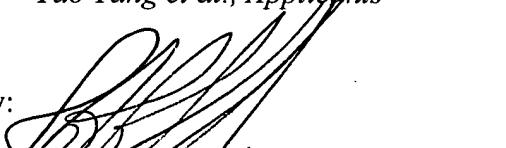
Attorney Docket No.:
E00295.70106.US



Respectfully submitted,

Yao Yang et al., Applicants

By:



Robert A. Skrivanek, Jr.
Reg. No. 41,316
WOLF, GREENFIELD & SACKS,
P.C.
600 Atlantic Avenue
Boston, Massachusetts 02210
Tel. (617) 720-3500